



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,672	04/13/2001	Robert W. Pries	056267-0003	5622

7590

06/24/2002

William K. Baxter
Godfrey & Kahn, S.C.
780 North Water Street
Milwaukee, WI 53202

EXAMINER

MCDERMOTT, KEVIN

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/834,672

Applicant(s)

PRIES, ROBERT W.

Examiner

McDermott, Kevin

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-24, 26-29 and 32 is/are rejected.
- 7) ☒ Claim(s) 25, 30, 31, 33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, line 2, recites "their". Examiner considers this language indefinite.

Claim 19, line 10 recites "construction assemblies". There is insufficient antecedent basis for this limitation in the claim.

Claim 20, line 3, recites "may". Examiner considers this language indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 20 as best understood, and claims 21-24, 26-29, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fay.

Regarding claims 19 and 27 and their recitation discussing the panel shapes being "derived from a three-dimensional grid defined by twenty-seven sub-cubes within a single larger cube", determination of patentability is based on the product itself. The

patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Regarding claims 19 and 27, Fay discloses an inventory of plates 10, which Examiner interprets as panel shapes in figures 1-9. Additionally, Fay discloses knuckles 11, which Examiner considers accounting for panel thickness and multiple combinations, for connecting the panels together. The knuckles 11 and pins 12 connect the panels about an axis centered between the panels. Fay discloses in column 1, lines 28-31, combining the panels 10 to form a variety of designs and figures. Examiner interprets this as including simple polygons and including any angle through 360 degrees about any axis between vertices and at a dihedral angle with respect to each other.

Regarding claims 19 and 28, Fay, figure 3 shows a plate 10 area between the knuckles 11 and openings 16 which Examiner interprets as a strut integral with the plate 10. The struts allow support the panel and allow connection to other panels.

Regarding claim 20, as best understood, the struts are offset from, parallel to and allow for rotation about an axis between vertices. Because Fay meets the structural limitations of claim 20, Examiner considers it inherently capable of performing the functions recited in the claim.

Regarding claims 21 and 26, Fay discloses in figure 10, connecting plates 10 together while maintaining a space between the plate 10 sides. Examiner considers the

knuckles 11 and pins 12 as constituting a connection mechanism. Because Fay discloses using a plurality of panels, more than one connection mechanism is required.

Regarding claim 22, Fay discloses in figures 1-8 and column 2, lines 26-31, knuckles 11 (part of the aforementioned connection mechanism) located in the space between the plate 10 sides, and the knuckles 11 being shaped into open-ended cylindrical segments of tubing centered on the axis between panels.

Regarding claims 23 and 24, Fay discloses knuckles 11 having a flat portion leading into a cylindrical portion. Examiner considers the flat portion as constituting a web along the strut corners and an extension bracket at the strut sides, and bridging the space between the struts and the open-ended cylindrical segments of tubing.

Regarding claims 29 and 32, Fay discloses knuckles 11 located at plate 10 corners and along the plate 10 sides. Examiner interprets the knuckles 11 along the plate 10 sides as constituting one joinery system, and the knuckles 11 located at the plate 10 corners as constituting a second joinery system. Fay discloses knuckles 11 between plates 10. Examiner interprets these knuckles 11 as constituting brackets bridging the space between plates 10. Additionally, examiner interprets the knuckles 11 as being an element bridging the space between plates 10, and having a flat portion adjacent the plate 10. Consequently, Examiner also considers the knuckles 11 to constitute the element of claim 15 bridging the space between the plates 10. The brackets have an arcuate shape designed for accommodating the pins 12, which pins hold the plates 10 in assembled relation. Examiner interprets the pin 12 as a tubular element.

Allowable Subject Matter

Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose a panel having the limitations of claim 19, wherein the struts are joined to a common tubing element by means of webs and brackets.

Claims 30 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose an inventory of panel shapes wherein each panel has a first joinery assembly comprising a web attached to panels struts, at least one collar with an opening, at least one tab extension extending from one side of the collar that attaches to the at least one web fastener, and a tubular element that extends through the opening in the at least one collar for connecting a plurality of panels together.

Claim 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not disclose the second joinery system that include joint closures for covering the space between the struts and bracing elements for securing the panels in place.

Response to Arguments

Applicant's arguments filed April 11, 2002 have been fully considered but they are not persuasive.

Applicant asserts several arguments. Applicant argues that the Fay reference is directed towards a toy construction system and not an architectural scale construction system for constructing life size buildings. The claims do not claim a building, but a modular construction system. As long as the structural features of a claim are satisfied in a 35 U.S.C. sec. 102 rejection, the reference is considered inherently capable of performing the same functions as the claimed invention. The Fay reference satisfies several of the structural limitations as explained above.

Applicant next argues that Fay only includes a limited number of two-dimensional shapes, and that only 10 polygons can be formed compared with at least 108 with the invention. However, the claims only recite an inventory of panel shapes, not a specific number.

Applicant argues that the panels of the invention can be connected in limitless combinations. However, again the claims do not reflect this sentiment. The claim

Art Unit: 3635

language indicates, in several of the claims, that "any" axis, or "any" two vertices. As long as the reference has one of these features, it satisfies the limitations of the claim.

Applicant argues that the connection mechanism of the present invention is different than the Fay reference. Examiner agrees that the disclosure describes a method of connecting the plates that is different from Fay. However, the claims, written as broadly as they are, do not differentiate from Fay.

Applicant's last argument asserts that the invention has more options for connecting plates together than the Fay reference. That may be true. However, the claims are not written to reflect this sentiment and at the same time distinguish over Fay.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3635

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin McDermott, whose telephone number is 703-308-8266.



Carl D. Friedman
Supervisory Patent Examiner
Group 3600

KM 6/19/02